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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,265

03/09/2004

Sande Berger

SB - 1000

2372

7590 03/27/2007  
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EXAMINER

MATTER, KRISTEN CLARETTE

ART UNIT

PAPER NUMBER

3771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/796,265

Applicant(s)

BERGER ET AL.

Examiner

Kristen C. Matter

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because in Figures 1-4 lines, numbers, and letters are not uniformly thick and have poor quality. Furthermore, the figure legends are poor in Figures 1-4. In all figures, numbers, letters, and reference characters must be at least 32 cm in height. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 6, and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear which portion "said portion" is referring to because both a plantar base portion and a distal base portion are mentioned proceeding the term. Furthermore, the terminology used in the claim is inconsistent. The plantar base zone is referred to as "said planter" in claim 1b and "said plantar base zone" in claim 1c.

Claim 3 recites the limitation "the plastic material" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 6 and 8-10 recite the limitation "the material" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 7, "head and shoulder shape" is undefined and vague. It is not clear what the scope of this shape is as heads and shoulders come in many forms.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurth et al. (US 3,429,302). Kurth et al. teaches a toe aeration appliance made of rubber or pliable materials where no adhering or holding devices are necessary to keep the appliance in place between toes. The toe aeration appliance comprises a plurality of laterally extending base portions with laterally spaced upstanding projection portions which widen towards the distal part of the projection and come up past the distal part of the toes (see abstract and Figure 1). The distal part of the projection is generally semi-circular in shape (see Figure 1). Kurth et al. further teaches that the appliance may easily be cut with a pair of scissors if the wearer wishes to aerate only one or two of the toe spaces (see column 2, lines 0-5) and that the device may be removed for sterilization (see column 1 , lines 55-60).

Regarding claim 1, the plantar base zone is described by the laterally extending base portions taught by Kurth et al., the dorsal flap is described by the top of the upstanding projections taught by Kurth et al., and the web spacer is described by the narrower portion of the upstanding projections taught by Kurth et al.

Regarding claim 2, the inert plastic is described by the pliable material that needs no adhering devices to stay in place taught by Kurth et al.

Regarding claim 3, the viscoelastic plastic material is described by the rubber material taught by Kurth et al.

Regarding claim 4, the semi-circular dorsal flap is described by the semi-circular distal portion of the upstanding projection taught by Kurth et al.

Regarding claim 5, the wings on the planter base are described by the laterally extending base portions that may be cut by the user taught by Kurth et al.

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Regarding claim 7, the head and shoulder shape can be described by the semi-circular distal portion of the upstanding projections as connected to the laterally extending base portions taught by Kurth et al.

Regarding claim 10, the sterile material is described by the material that may be removed for sterilization taught by Kurth et al.

Claims 1, 3, 6, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Crunkleton (US 2004/0167454 A1). Crunkleton teaches a symptomatic relief for soft corns made of a viscoelastic gel, such as dental molding medium that does not irritate the skin but adheres to the toes. Furthermore, the material is highly resistant to any chemicals approved for contact with the skin, allowing the use of medication while using the mold (see paragraph 36). Regarding the structure of claim 1, Crunkleton teaches a flat base portion and a flat distal portion with a web spacer (see Figure 5).

Regarding claim 3, the viscoelastic plastic material is described by the viscoelastic gel taught by Crunkleton.

Regarding claim 6, the material containing therapeutically effective medicine is described by the material that allows use of medications taught by Crunkleton.

Regarding claim 10, the sterile material is described by the dental material taught by Crunkleton.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurth et al. in view of Dumitrascu (US 2003/0230312 A1). The teachings of Kurth et al. are discussed above. Kurth et al. does not specifically teach a color or material or a transparent material. Dumitrascu teaches an article of skin protection for the foot comprising a sheet of skin-colored or transparent material (see abstract and paragraph 9).

Regarding claim 8, it would have been obvious to one of ordinary skill in the art to make the protective device described in the current application a skin-color as taught by Dumitrascu for cosmetically appealing protection.

Regarding claim 9, it would have been obvious to one of ordinary skill in the art to make the protective device described in the current application transparent as taught by Dumitrascu for cosmetically appealing protection.

### ***Response to Arguments***

Applicant's arguments, filed 1/29/07, with respect to the 35 U.S.C. 112, 1<sup>st</sup> paragraph, rejection have been fully considered and are persuasive. The 35 U.S.C. 112, 1<sup>st</sup> paragraph, rejection of the Action mailed on 9/25/06 has been withdrawn.

Applicant's arguments filed 1/29/07 have been fully considered but they are not persuasive.

In response to applicant's argument that the Kurth et al. reference fails to show each and every feature of the present invention, Examiner directs applicant's attention to Figure 3. Figure 3 clearly shows a plantar base zone extending medially and laterally conforming to the base of the metatarsal phalangeal joint, a dorsal flap zone that extends over the dorsal area of the foot, and a web spacer zone of lesser width than the plantar base zone and the dorsal flap zone that touches adjacent toes.

In response to applicant's argument that the Crunkleton reference fails to show each and every feature of the present invention, Examiner directs applicant's attention to Figure 5a. Figure 5a clearly shows a plantar base zone extending medially and laterally conforming to the base of the metatarsal phalangeal joint, a dorsal flap zone that extends over the dorsal area of the foot, and a web spacer zone of lesser width than the plantar base zone and the dorsal flap zone that touches adjacent toes. The process by which the Crunkleton product was made is not relevant to the scope of the claims.

In response to applicant's argument that the Crunkleton and Kurth et al. references are not for protecting against frictional irritation from thong-type sandals, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that one of ordinary skill in the art would find no suggestion to combine the Kurth et al. and Dumitrascu references, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied



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upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Kurth et al. and Dumitrascu references are in the field of footcare and it would not have been unreasonable for one of ordinary skill in the art to turn to find incentive to provide transparent and flesh colored materials to the Kurth et al. reference from the Dumitrascu reference at the time the invention was made.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen C. Matter whose telephone number is (571) 272-5270. The examiner can normally be reached on Monday - Friday 9-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kristen C. Matter  
Examiner  
Art Unit 3771



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3/20/07